

REMARKS

In response to the final Office Action dated May 26, 2006, the Assignee respectfully requests reconsideration based on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents to *Combar*, *Luzeski*, *Stem*, *Kung*, and *Gupta*.

Claims 1-57 are pending in this application.

The United States Patent and Trademark Office (the "Office") objected to the drawings. The Office also rejected claims 1, 2, 16, 17, and 30-44 under 35 U.S.C. § 112 for failing to comply with the enablement requirement and/or the written description requirement. Claims 30-43 were rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter. Claims 1, 16, 30, and 44 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,430,177 to Luzeski *et al.* Claims 1, 3, 16, 30-31, and 44-45 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,515,968 to Combar *et al.* in view of Luzeski. Claims 2, 17, and 57 were rejected under 35 U.S.C. § 103 (a) as being obvious over Combar in view of Luzeski and further in view of U.S. Patent 6,731,927 to Stem *et al.* Claims 4-6, 8-14, 18-20, 22-28, 32-34, 36-42, 46-48, and 50-56 were rejected under 35 U.S.C. § 103 (a) as being obvious over Combar in view of Luzeski and further in view of U.S. Patent 6,917,610 to Kung *et al.* Claims 7, 15, 21, 29, 35, 43, and 49 were rejected under 35 U.S.C. § 103 (a) as being obvious over Combar in view of Luzeski, Kung, and Published U.S. Patent Application 2002/0099777 to Gupta *et al.*

The Assignee shows, however, that the pending claims are not anticipated nor obviated by the cited documents. The Assignee thus respectfully submits that the pending claims already distinguish over the cited documents.

Objection to the Drawings

The Office objected to the originally-submitted informal drawings. This response includes formal drawings that fully comply with § 1.81.

Rejection of Claims under § 112

- 1) The Office rejected claims 30-43 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. “The test of enablement is whether one reasonably skilled in the art could make or use the invention from the [disclosure] coupled with information known in the art without undue experimentation.” M.P.E.P. § 2164.01 (quoting *United States v. Teletronics, Inc.*, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). “A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement.” M.P.E.P. § 2164.04.

The Assignee, however, strongly asserts that the enablement requirement is satisfied. The originally-filed disclosure contains ample teachings which correspond in scope to claims 30-43. The specification, for example, teaches that an “*exemplary embodiment of the inventions implements the CIR manager through the use of a computer program stored on a computer-readable medium and used in a computer.*” U.S. Application 09/966,703 at page 7, lines 15-28 (emphasis added). This same paragraph continues to teach:

A user may access the CIR manager through the use of a computer such as a personal computer (PC). For example, an icon or other graphic device may be created by the computer program for display on the desktop presented on the monitor of the user's computer. Typically, the computer program implementing the CIR manager is a persistent desktop presence. When the user activates the icon of the CIR manager, an initial screen of the graphic user interface (GUI) is displayed to the user. The GUI may include myriad screens for displaying information to the user, for displaying communications and/or data about the communications to the user, for displaying information about the user such as user data, for receiving information from the user, for reporting on actions to the user, and for similar information.

U.S. Application 09/966,703 at page 7, lines 17-28. The Assignee thus strongly asserts that the enablement requirement is satisfied. Examiner Duong is requested to remove the § 112 rejection of claims 30-43.

- 2) The Office also rejected claims 30-43 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. “To comply with the written description requirement ..., each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure.” Department of Commerce, Manual of Patent Examining Procedure § 2163 (II) (3) (b) (Rev. 1, Feb. 2003) (hereinafter “M.P.E.P.”). Here Examiner asserts that the specification does not disclose a computer readable medium, as claimed. The specification, however, teaches that an “exemplary embodiment of the inventions implements the CIR manager through the use of a **computer program stored on a computer-readable medium** and used in a computer.” U.S. Application 09/966,703 at page 7, lines 15-28. The Assignee thus strongly asserts that the written description requirement is satisfied. Examiner Duong is requested to remove the § 112 rejection of claims 30-43.
- 3) The Office also rejected claims 1, 16, 30, and 44 for indefiniteness. These claims have been amended as Examiner Duong suggests, so the rejection is now moot.
- 4) The Office also rejected claims 2, 17, and 57 for improper antecedent basis. These claims have been amended as Examiner Duong suggests, so the rejection is now moot.

Rejection of Claims under § 101

Claims 30-43 were rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter. As Examiner Duong suggests, independent claim 30 has been amended to recite a “computer-readable storage medium on which is stored a computer program for managing communications of a user.” The rejection is thus moot.

Rejection of Claims under § 102

Claims 1, 16, 30, and 44 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,430,177 to Luzeski *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

Luzeski, however, cannot anticipate claims 1, 16, 30, and 44. The patent to Luzeski *et al.* fails to disclose “receiving voicemail data from the telecommunications manager and from the gateway regarding voicemail messages that have been received by the user and that have been recorded by the user,” as claims 1, 16, 30, and 44 similarly recite. Examiner Duong is correct — the patent to Luzeski *et al.* discloses a unified messaging system having a “Voice Mail Message Manager” or “VMMM.” *See, e.g.*, U.S. Patent 6,430,177 to Luzeski *et al.* (Aug. 6, 2002) at column 5, lines 35-40. No where, however, does *Luzeski* describe this VMMM as having any capability of “receiving voicemail data ... regarding voicemail messages ... that have been recorded by the user,” as claims 1, 16, 30, and 44 similarly recite. The patent to Luzeski *et al.* discusses recording a voicemail message (*see id.* at column 12, lines 32-47), email notifications for failed voicemail recipients (*see id.* at column 12, lines 48-57), storage of voicemail messages (*see id.* at column 18, lines 55-60), and a “universal inbox” for messages (*see id.* at column 18, lines 60-65). The patent to Luzeski *et al.* also discusses viewing this inbox (*see id.* at column 20, lines 7-30), opening voicemail messages (*see id.* at column 20, line 55 through column 21, line 5), and deleting voicemail messages (*see id.* at column 22, lines 20-40). Despite these teachings, *Luzeski* fails to specifically disclose “receiving voicemail data from the telecommunications manager and from the gateway regarding voicemail messages that have been received by the user and that have been recorded by the user,” as claims 1, 16, 30, and 44 similarly recite.

One more important point. The patent to Luzeski *et al.* does discuss a message component describing a “data/time message was sent (submitted).” U.S. Patent 6,430,177 to Luzeski *et al.* (Aug. 6, 2002) at column 16, lines 16 and 35. Examiner Duong should realize, however, that this “time sent” component describes a “CMC message structure” that is sent from an “CMC API (Email Front End).” *Id.* at FIG. 2 and at column 14, lines 56-60. *See also id.* at column 16, lines 5-25. This “time sent” component does NOT describe voicemail messages.

Luzeski, then, cannot anticipate claims 1, 16, 30, and 44. The patent to Luzeski *et al.* fails to disclose “receiving voicemail data ... regarding voicemail messages ... that have been recorded by the user,” as claims 1, 16, 30, and 44 similarly recite. Because *Luzeski* is silent to at least this feature, *Luzeski* cannot anticipate these claims. The Assignee thus respectfully requests removal of the § 102 rejection of claims 1, 16, 30, and 44.

Rejection of Claims under § 103

The Office variously rejects claims 1-57 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,515,968 to Combar *et al.* in view of *Luzeski* and further in view of various combinations of U.S. Patent 6,731,927 to Stem *et al.*, U.S. Patent 6,917,610 to Kung *et al.*, and Published U.S. Patent Application 2002/0099777 to Gupta *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

For the following reasons, the Office’s *prima facie* cases for obviousness fail.

1. Because Not All Features Are Taught/Suggested, the *Prima Facie* Cases Must Fail

Claims 1-57 cannot be obvious. These claims all recite, or incorporate, features that are not taught or suggested by *Combar*, *Luzeski*, *Stem*, *Kung*, and/or *Gupta*, whether alone or in any combination. As explained above, for example, any combination of *Combar*, *Luzeski*, *Stem*, *Kung*, and/or *Gupta* fails to teach or suggest “receiving voicemail data ... regarding voicemail messages ... that have been recorded by the user,” as the independent claims all similarly recite. Because the cited documents are all entirely silent to such features, one of ordinary skill in the art would not consider claims 1-57 to be obvious in view of *Combar*, *Luzeski*, *Stem*, *Kung*, and/or *Gupta*, regardless of their proposed combination. The *prima facie* cases for obviousness, therefore, must fail, so Examiner Duong is respectfully requested to remove the § 103 rejections.

2. Because No “Teaching, Suggestion, or Motivation” was Cited, the § 103 (a) *Prima Facie* Cases for Obviousness Are Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner’s *prima facie* cases for obviousness must include “some teaching, suggestion, or motivation” to combine prior art that is found “either in the references themselves or in the knowledge generally available to one of ordinary skill.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

Here, however, the Examiner’s *prima facie* cases fail to include any teaching, suggestion, or motivation. While Examiner Duong quotes passages from *Combar*, Examiner Duong fails to specifically make any teaching, suggestion, or motivation. The *prima facie* cases for obviousness, then, are at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires.

3. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Cases for Obviousness Are Improper

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The Examiner's *prima facie* cases for obviousness are defective for another reason. The Examiner's *prima facie* cases for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* cases wholly fail to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must fail. The Appellant thus respectfully asserts that the § 103 (a) rejection of claims 1-57 should be removed.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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